



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,593	12/23/2003	William J. Jetter	014033.000015	1592

24239 7590 05/12/2009
MOORE & VAN ALLEN PLLC
P.O. BOX 13706
Research Triangle Park, NC 27709

EXAMINER

IWARERE, OLUSEYE

ART UNIT	PAPER NUMBER
----------	--------------

3687

MAIL DATE	DELIVERY MODE
-----------	---------------

05/12/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/707,593	Applicant(s) JETTER ET AL.	
	Examiner OLUSEYE IWARERE	Art Unit 3687	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-65 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to the correspondence received on July 15, 2008. Amendments to claims 1 and 4 – 6 have been entered and have been considered below.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 19, 2009 has been entered.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 1, 4 – 14, 18 – 31, 35 – 47 and 51 – 65 are rejected under 35 U.S.C. 102(e) as being anticipated by Praisner et al. (7,319,986).**

As per claims 1, 10, 14, 21, 37 – 39, 44, 52, 53 59 and 60, Praisner discloses a system, method and computer-readable medium having computer-executable instructions performing a method to manage a supply chain, comprising:

a purchase order management module operable on a processor to electronically receive purchase order information from a buyer and to store and track information associated with each purchase order (fig. 1 depicts receiving purchase order information, storing and tracking);

an invoice and trade document management module to electronically store, aggregate and manage invoices and trade documents related to each purchase order and required for presentment and reconciliation of each purchase order (fig. 1 item 122 depicts reconciliation and fig. 8D depicts invoices);

a payment construction module to create a payable instrument in response to receiving the purchase order information, wherein the payable instrument comprises an instrument that is payable upon fulfillment of payment conditions (fig. 1 depicts payment creation);

an agreement management module to warehouse, adjudicate and provide status reporting on payment conditions related to each purchase order (fig. 8B depicts and col. 34, line 66 – col. 35, line 21 discusses warehousing, adjudicating and providing status reporting); and

a collaboration and workflow module to support and manage workflow between the other modules and between the buyer and a seller (fig. 1 item 102 depicts a collaboration and workflow module).

comprising a database associated with the purchase order management module to store and track information associated with each purchase order (fig. 1 block 120 depicts a database associated with the purchase order management module).

As per claims 22, 54, Praisner further discloses, comprising a database associated with the purchase order management module to store and track information associated with each purchase order (fig. 1 block 120 depicts a database associated with the purchase order management module).

As per claims 4 and 23, Praisner discloses wherein the payment construction module is adapted to sort approved purchase orders by a criteria predefined by the buyer (fig. 8A item 806 depicts order management also, see “Adapted To Clauses” paragraph below).

As per claims 5, 24 and 40, Praisner further discloses comprising a set of rules to control creation of each payable instrument (col. 33, line 51 – col. 34, line 20; discusses rules).

As per claims 6, 25, 41, 55 and 62, Praisner discloses wherein the payment construction module is adapted to support settlement under at least one of a binary condition, a qualified condition and a documentary condition, wherein settlement relates to payment from the buyer upon fulfilling the payment conditions set by the buyer (fig. 10A and col. 22, line 49 – col. 23, line 8; discuss settlement, also see "Adapted To Clauses" paragraph below).

As per claims 7, 26, 42, and 56 and 61, Praisner discloses wherein the payable instrument comprises at least one of a documentary credit instrument and an open account instrument (col. 12, lines 13 – 24 discuss credit instruments).

As per claims 8 and 27, Praisner discloses wherein the payment construction module is adapted to transmit information to the purchase order management module to indicate which purchase orders are covered under a documentary credit instrument (fig. 1 depicts and col. 37, lines 30 – 57 discusses transmission, see "Adapted To Clauses" paragraph below).

As per claims 9, 28 and 43, Praisner discloses wherein the payment construction module is adapted to send documentary credit information to a service provider to issue a documentary credit (col. 37, lines 30 – 57 discusses sending documentary credit information also, see "Adapted To Clauses" paragraph below).

As per claims 11, 29 and 45 and 63, Praisner discloses wherein the agreement management module is adapted to adjudicate payment conditions by tracking whether any payment conditions have been discharged (col. 4, line 49 – col. 5, line 5; tracking discusses payment conditions also see “Adapted To Clauses” paragraph below).

As per claims 12, 30, 46, 57 and 64, Praisner discloses wherein the agreement management module is adapted to compare seller discharge information to payment conditions to determine if the payment conditions have been discharged (col. 4, line 49 – col. 5, line 5; comparing information).

As per claims 13, 31, 47, 58 and 65, Praisner discloses wherein the agreement management module is programmable to discharge payment conditions on at least one of an exact match comparison or predefined variances from an exact match (col. 8, line 51 – col. 9, line 15; discusses comparison).

As per claims 18 and 35, Praisner discloses wherein the invoice and trade document management module is adapted to receive invoice information from a seller (fig. 8D item 876 depicts receiving invoice information, also see “Adapted To Clauses” paragraph below).

As per claim 19, Praisner discloses, wherein the invoice information is receivable via one of a printed format, facsimile and a communication network (fig. 1 depicts a communication network).

As per claims 20, 36 and 51, further comprising an image capture and key entry module to convert non-electronic information into predetermined electronic format for receipt and use by the invoice and trade document management module (fol. 5, lines 6 – 35 discusses conversion).

As per claims 38, 53 and 60, Praisner discloses wherein adjudicating any payment conditions comprises at least one of discharging any payment conditions, accepting any payment condition discrepancies or accepting any payment condition discrepancies with changes (fig. 2 depicts payment conditions).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 15 – 17, 32 – 34 and 48 – 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Praisner (7,319,986), in view of Land et al. (7,194,431).**

As per claims 15, 32 and 48, Praisner discloses the claimed invention but fails to explicitly further disclose comprising a negotiation tool to enable the buyer and seller to negotiate and document discrepancies or disputes.

Land teaches a method and apparatus for managing remittance processing within account receivables wherein the negotiation tool comprising a negotiation tool to enable the buyer and seller to negotiate and document discrepancies or disputes (col. 1, lines 6 – 12; discusses dispute management).

From this teaching of Land it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the dynamic payment cards and related management systems and associated methods of Praisner to include the negotiation tool taught by Land, in order to resolve problems associated with the process.

As per claims 16, 33 and 49, Praisner discloses the claimed invention but fails to explicitly disclose wherein the negotiation tool comprises a browser to negotiate disputes or discrepancies interactively and on-line.

Land teaches a method and apparatus for managing remittance processing within account receivables comprising a browser to negotiate disputes or discrepancies interactively and on-line (fig. 3 depicts a browser).

From this teaching of Land it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the dynamic payment cards and

Art Unit: 3687

related management systems and associated methods of Praisner to include the browser taught by Land, in order to resolve problems associated with the process.

As per claims 17, 34 and 50, Praisner discloses the claimed invention but fails to explicitly disclose wherein the collaboration and workflow module comprises a digital rights management feature to manage rights to and ownership of electronic title documents.

Land teaches a method and apparatus for managing remittance processing within account receivables wherein the collaboration and workflow module comprises a digital rights management feature to manage rights to and ownership of electronic title documents (col. 12, lines 50 – 57; discusses ownership).

From this teaching of Land it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the dynamic payment cards and related management systems and associated methods of Praisner to include the ownership management feature taught by Land, in order to provide verification.

Adapted To Clauses

7. It has been held that the recitation that an element is “adapted to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense.

In re Hutchinson, 69 USPQ 138

Response to Arguments

8. Applicant's arguments filed February 19, 2009 have been fully considered but they are not persuasive.

As per claim 1, Applicant argues, "there is absolutely no disclosure of an invoice and trade document management module, as recited in claim 1. Indeed, there is no disclosure of any module that stores, aggregates and manages invoices and trade document information that is related to each purchase order required for presentment and reconciliation of each purchase order"

However, fig. 8D depicts and col. 36, lines 36 – 49 disclose " In block 882, invoice data can be exported to corporate accounting systems, such as company system(s) represented by item 884." This corporate accounting system stores and aggregates invoice data as claimed. Therefore, the Examiner respectfully disagrees.

Applicant also argues "block 120 of Figure 1 of Praisner merely shows a dynamic purchase processing block and does not disclose a database." However, figure 8D, 884 depicts the database referred to. Therefore, the Examiner respectfully disagrees.

Applicant also argues, "Figure 1 of Praisner does not disclose any module that creates a payable instrument, where either payable instrument is an instrument that is payable upon fulfillment of payment conditions."

However, the abstract discusses a payment card that allows for the efficient management of corporate purchasing needs. The payment card is the payment instrument therefore, the Examiner respectfully disagrees.

As per claim 4, Applicant argues, "Praisner does not disclose a payment construction module is adapted to sort approved purchase orders according to predefined criteria, as recited."

However, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense.

In re Hutchinson, 69 USPQ 138

As per Claim 5, Applicant argues, "there is no disclosure in Praisner of a payable instrument... There is absolutely no disclosure in Praisnter of a set of rules which will control creation of a payable instrument.

However, the abstract states, "These dynamic approval parameters can be generated and/or managed through the application of configurable company purchasing policies and **rules**, and these dynamic approval parameters can be stored, for example, by a processing system that makes authorization determinations when transactions are initiated using the purchasing mechanisms." The creation of the payable instrument is the use of the payment card when the transaction is initiated.

Therefore, the Examiner respectfully disagrees.

As per claim 7, Applicant argues, “these cards are not ‘documentary credit instruments.’ Praisner does not disclose documentary credit instruments or open account payment instruments.

However, the Abstract discloses payment cards and col. 1, lines 30 – 37 discuss payment cards such as credit cards, which are open account payment instruments. Therefore, the Examiner respectfully disagrees.

As per claim 10, Applicant argues, “There is no mention of payment conditions, only approval of purchase requests.”

However, the Abstract discusses approval parameters and company purchasing rules that are construed as payment conditions. In order to gain approval, the transaction must comply with the parameters.

“Further, Applicants respectfully submit that there is no disclosure, teaching or suggestion of an agreement management module to ‘warehouse, adjudicate and provide status reporting on payment conditions related to each purchase order.’”

However, fig. 1, 122 depicts transaction reconciliation and reporting, which serves the functions of the claimed module. Therefore, the Examiner respectfully disagrees.

As per claim 11, Applicant argues “There is no discussion in Praisner of tracking anything and there is no discussion of payment conditions being discharged where payment conditions are required to be met before payment is required.

However, it has been held that the recitation that an element is “adapted to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense.

In re Hutchinson, 69 USPQ 138

In addition, col. 35, line 50 – col. 36, line 12 discloses, “If the purchase request is approved in block 824, flow can proceed to block 826 where it can be determined whether additional approval is required. If the answer is “YES,” flow can proceed to an additional approval cycle as indicated in FIG. 8B. If the answer is “NO,” flow can continue to order management activities 806 as represented by element 828,” which is construed as payment conditions being met. Therefore, the Examiner respectfully disagrees.

As per claim 14, Applicant argues, “There is no discussion in Praisner of the specific feature of a collaboration workflow module to support and manage workflow between the other modules and between the buyer and seller.

However, fig. 1 depicts the Purchasing Management System, which also serves the functionality to manage workflow between modules, the buyer and seller. Therefore, the Examiner respectfully disagrees.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to OLUSEYE IWARERE whose telephone number is (571)270-5112. The examiner can normally be reached on M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew S. Gart can be reached on (571)272-3955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew S Gart/
Supervisory Patent Examiner, Art
Unit 3687

OI